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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,871	03/26/2001	Felix Frey	27656/37082	1259

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EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/13/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/762,871

Applicant(s)

FREY ET AL.

Examiner

Barbara P. Badio, Ph.D.

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6,7,9-11,14,17 and 20-33 is/are pending in the application.
- 4a) Of the above claim(s) 20-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,7,9-11,17 and 30-33 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

**Final Office Action on the Merits**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

2. The rejection of claims 2-5, 8, 12-13, 18 and 19 under 35 USC 112, first paragraph is made moot by the cancellation of the instant claims.
3. The rejection of claim 14 under 35 USC 112, first paragraph is withdrawn.
4. The rejection of claims 1, 6, 7, 9-11, 17 and 30 under 35 USC 112, first paragraph is maintained and claims 31-33 are rejected under 35 USC 112, first paragraph.

Applicant argues that a DNA-interacting molecule has been defined in the specification and that the term is self-defining. Applicant's argument was considered but not persuasive for the following reason.

Page 4, paragraph 5 of the present specification referred to by applicant recites "DNA-interacting molecule is selected from the group consisting of one or more of intercalating agents, crosslinking reagents, incorporating molecules and ionically interacting molecules". The terms utilized to define said DNA-interacting molecule(s) are not defined by the present specification nor do they have an established meaning in

Art Unit: 1616

the art. Applicant also argues that the term is self-defining. However, the issue is not the plain meaning of the combination of words but what applicant intends by the use of said combination of words. Because the terms disclosed by the present specification to define a "DNA-interacting molecule" do not have an established meaning in the art and the skilled artisan would not know what applicant intends by either a the use of the term "DNA-interacting molecule" and the terms used by applicant to define said molecule, he would be unable to make and use the claimed invention commensurate in scope with the instant claims.

For these reasons and those given in Paper No. 12, the rejection of claims 1, 6, 7, 9-11, 17 and 30 under 35 USC 112, first paragraph is maintained and claims 31-33 are rejected under 35 USC 112, first paragraph.

**5. The rejection of claims 2-5, 8, 12-13, 18 and 19 under 35 USC 112, second paragraph is made moot by the cancellation of the instant claims.**

**6. The rejection of claim 14 under 35 USC 112, second paragraph is withdrawn.**

**7. The rejection of 1, 6, 7, 9-11, 17 and 30 under 35 USC 112, second paragraph is maintained and claims 31-33 are rejected under 35 USC 112, second paragraph.**

Applicant's argument and the examiner's response are as discussed above in #4.

***Claim Rejections - 35 USC § 102***

8. The rejection of claims 2, 3, 5, 8, 12, 13, 18 and 19 under 35 USC 102(b) over Ponpipom et al. is made moot by the cancellation of the instant claims.

9. The rejection of claims 1, 6, 7, 10-11, 17 and 30 under 35 USC 102(b) over Ponpipom et al. is withdrawn.

***Allowable Subject Matter***

10. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Note: The instant claim is allowable to the extent it reads applicant's elected species.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1616

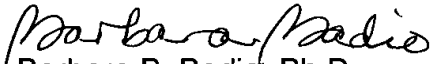
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308- 2927. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1616

BB  
November 10, 2003